THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL T. WISOR and RITA M. O'BRIEN

Appeal No. 97-2472
Application No. 08/223,770[1]

ON BRIEF

Before THOMAS, BARRETT, and BARRY, Administrative Patent Judges.
BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from a final rejection of claims 1 through 18, which are all the claims in the application.

We reverse.

[1] Application for patent filed April 6, 1994.

BACKGROUND

The invention relates to configuring a computer 100. The invention employs a programmable register, viz., program register 124, to set the address of an index register 126 and an associated configuration data register. A user can program the address to avoid conflicts with peripheral devices that occupy predetermined addresses in the computer's input/output address space 204.

Claim 15, which is representative for our purposes, follows:

15. A method for accessing a plurality of configuration registers within a power management unit of a computer system comprising the steps of:
storing a value within a program register that sets an address location of an index register;
storing an index value within said index register by executing a write cycle to said address location of said index register;
enabling a selected one of said plurality of configuration registers according to said index value; and
writing configuration data into said selected one of said plurality of configuration registers.

The references relied upon by the patent examiner in rejecting the appealed claims follow:

Fung	5,396,635	Mar. 7, 1995 (filed Feb. 12, 1993)
Faucher et al. (Faucher)	5,404,543	Apr. 4, 1995 (filed May 29, 1992).

Claims 1-18 stand rejected under 35 U.S.C. § 103 as unpatentable over Fung in view of Faucher. Rather than repeat the arguments of the appellants or examiner in toto, we refer to the appeal brief and the examiner's answer for the respective details thereof.

OPINION

In reaching our decision in this appeal, we have considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence supporting the rejection. We have also considered the appellants' arguments along with the examiner's arguments in rebuttal. After considering the record before us, it is our view that the collective evidence relied on and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention of claims 1-18. Accordingly,

we reverse. Our opinion discusses the grouping and nonobviousness of the claims seriatim.

Grouping

The appellants state that the claims should be considered as a single group for the appeal. (Appeal Br. at 7.) Consistent with this statement, the appellants do not argue separately the patentability of the claims within the rejection. Accordingly, all claims within the rejection stand or fall together. See In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983); 37 C.F.R. § 1.192(c)(7); Manual of Patent Examining Procedure § 1206.

Nonobviousness

In rejecting claims under 35 U.S.C. § 103, the patent examiner bears the initial burden of establishing a prima facie case of obviousness. A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person having ordinary skill in the art. If the examiner

fails to establish a prima facie case, an obviousness rejection is improper and will be overturned. In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). With this in mind, we analyze the examiner's rejection of the appealed claims.

Regarding claim 15, the examiner notes that Fung teaches configuration registers 57-60, an index decoder 70, an index register 50, and a control unit 13. He admits that Fung differs from the claimed invention "by not explicitly teaching a program register." (Examiner's Answer at 3.)

The examiner opines that Faucher teaches a program register, which is "inherent" in memory controller 20. (Id.) The inherent register, he explains, controls which addresses will be used in memory and thus what addresses will be assigned to registers mapped to that memory space. The examiner cites col. 5, ll. 51-53 and col. 7, l. 59 to col. 9, l. 48 of Faucher in support of his interpretation. (Id. at 3-4.) He concludes that it would have been obvious to combine Faucher with Fung to provide "a more flexible method for

controlling and configuring power control parameters, since constraints on memory space could easily be overcome." (Id. at 5.)

In deciding that a novel combination would have been obvious, there must be supporting teaching in the prior art. In re Newell, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989). In applying this precedent to the appellants' invention, we agree with the appellants that the claimed program register differs from the cited address control scheme of Faucher. (Appeal Br. at 10.) Claim 15 specifies in pertinent part "storing a value within a program register that sets an address location of an index register ...." This is neither taught nor suggested by Faucher.

The cited portions of the Faucher reference disclose an address compare/bank select/remapping unit 58 within a memory controller 20. The unit receives an address from a central processing unit 12 or other component. It "performs an address compare" to determine which of Faucher's memory banks 30 corresponds to the address. Col. 5, ll. 48-51. The unit

58 supplies the address and the determined "bank information" to a system memory machine 60. Id. at ll. 61-64. In addition, it "handles remapping of one address to another." Id. at ll. 51-53.

When Faucher's computer is initialized, the unit 58 is configured "to indicate address mapping and the addressing mode." Col. 8, ll. 9-10 and 56-60. In addition, when the amount of memory available to the computer exceeds that which it requires, the reference allocates only the number of memory banks 30 needed to satisfy the requirement. This is accomplished using the unit 58 to reconfigure memory addresses. Col. 9, ll. 32-40.

It is evident that the address compare/bank select/remapping unit 58 fails to teach or suggest storing a value that sets an address location of an index register as specified in claim 15.

Assuming arguendo that there was a proper suggestion or motivation to combine Fung with Faucher, the examiner's rejection still would not amount to a prima facie case of obviousness.

Similar to claim 15, the other independent claims, viz., claims 1 and 8, specify a program register for storing a value that sets an address location of the index register. This language similarly is neither taught nor suggested by Fung in view of Faucher. Because the examiner has not established a prima facie case, the rejection of claims 1-18 over Fung in view of Faucher is improper and is reversed.[2]

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-18 under 35 U.S.C. § 103 is reversed.

[2] Our reversal of the rejection of claims 1-18 is based only on the disclosures of Faucher and Fung. It should not prevent the examiner from finding and applying a reference that teaches expressly the storing of a value that sets an address location of an index register as claimed.

REVERSED

JAMES D. THOMAS Administrative Patent Judge	)	
LEE E. BARRETT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)	

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APPEAL NO. 97-2472 - JUDGE BARRY
APPLICATION NO. 08/223,770

APJ BARRY

APJ THOMAS

APJ BARRETT

DECISION: **REVERSED**

Prepared by: Gloria Henderson

DRAFT TYPED: 21 Mar 00

FINAL TYPED: